REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set is fully supported by the originally filed specification.

Claim Rejections – 35 USC § 103

At page 2 of the Final Office Action, the Examiner rejects claims 1 to 19 under 35 U.S.C. §103 as being unpatentable over Montlick (U.S. Patent No. 5,561,446) as modified by Baldwin (U.S. Patent No. 5,884,425) in view of Ukai (U.S. Patent No. 5,696,365).

Claims 1 and 11 have now been amended to include the subject matter of claim 10 and 19 respectively specifying that the coded data is at least substantially invisible in the visible spectrum.

At page 10 of the Office Action, the Examiner rejects previous claims 10 and 19 as being unpatentable over Montlick. Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Examiner has rejected claim 10 and 19 based on the disclosure of Montlick. The Examiner states that:

> *"[e]ven though the information (the handwritten notes) contained in the document is* ***unintelligible*** *(where "substantially invisible" is considered unintelligible),* ***to the computer****, the information can be retrieved and displayed in the context which gives it meaning to a user (column 8, lines 45-48)."* (emphasis added)

It is respectfully submitted that this reasoning is illogical. The coded data is substantially invisible to the user. A such, the sensing device may be used to sense the invisible coded data, and the sensed coded data is sent to the computer system. Thus, the computer system uses the sensed coded data to determine the operative use of the sensing device relative to the printed form.

Therefore, the applicant questions the reasoning that it would be obvious to modify Montlick, since the visible handwritten notes disclosed by Montlick **are not intelligible to the computer**, yet in regard to the claims, the substantially invisible coded data **is intelligible to the computer.**

The coded data is not visible to a user so as to allow a user to not be visually aware of the coded data whilst the sensing device is operatively used. Comparisons should not be drawn with Montlick's system which discloses visual handwritten notes which the computer cannot interpret. The common "*unintelligible nature*" of the handwritten notes and the coded data has been misconstrued by the Examiner and would not be relevant to a person skilled in the art.

We respectfully request that the Examiner reconsider the subject matter of previously presented claims 10 and 19 (now included in amended claims 1 and 11) and withdraw the rejection.

If the Examiner is not persuaded by these arguments, we refer to M.P.E.P. §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" which states that:

> "*... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*
>
> *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*"

The Examiner has failed to provide suitable motivation to combine Montlick with Ukai in regard to claims 1 and 11. Furthermore, the Examiner has failed to show a reasonable expectation of success for combining Montlick with Ukai in regard to claims 1 and 11, when clearly the cited documents teach otherwise, as will be discussed below.

Montlick discloses a method and system for wireless information retrieval using one or more pen-based computers. Each pen-based computer displays each retrieved form on an electronic graphical interface, and receives input from the a stylus.

The Examiner maintains in the Office Action that Montlick teaches providing a printed registration form including coded data thereon by referring to column 2, lines 63-67. However, the Examiner is misconstruing the disclosure by Montlick as clearly Montlick is not a "printed" form under normal interpretations.

Montlick teaches the very opposite. Lines 63-67 disclose providing a digital stored registration form using an electronic screen. Montlick highlights a major deficiency of a paper based system at lines 39 to 41 of column 1:

> *"This information is then later transcribed by clerks using terminals so that the information can be stored for later retrieval"*

Montlick teaches that a paper-based systems suffer from the disadvantage of having the information transcribed, and thus being inefficient. Therefore a computerised system such as a stylus/tablet system overcomes this inefficiency.

In total contrast, Ukai teaches "a paper media system" for reading bar codes printed on a paper media with contents of a document (Abstract).

The applicant respectfully submits that there would be no motivation for one skilled in the art to modify the teachings of Montlick with Ukai. Montlick teaches a computerised method of displaying forms to overcome inefficiency suffered from paper-based forms. In total contrast, Ukai teaches using a paper media system to print a document.

Therefore, as stated by M.P.E.P §2143, the Examiner has failed to show the first requirement of a prima facie case of obviousness, in that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Additionally, Montlick teaches that paper-based system suffer from the disadvantage of having the information transcribed, and thus being inefficient. Thus, clearly this document indicates to a person skilled in the art that there is little success with using paper-based technologies. Thus, a skilled person in the art would not have a reasonable expectation of success using a paper based technology based on the comments of Montlick.

Therefore, as stated by M.P.E.P §2143, the Examiner has failed to show the second requirement of a prima facie case of obviousness, in that there must be a reasonable expectation of success.

Thus, as the Examiner has failed to adequately show the first and second requirements of a prima facie case of obviousness based on M.P.E.P §2143, we respectfully request that the Examiner withdraw the rejection.

If the Examiner continues to maintain a prima facie case of obviousness, we would appreciate if the Examiner followed the guidelines provided at M.P.E.P §2143 such that all three requirements are shown in order to substantiate such a rejection.

We have additionally included new claims 20 and 21 to further define distinguishing features of the claimed system.

In particular, claim 20 specifies that the coded data and the registration information are substantially coincident on the paper form. None of the cited documents show that the coded data and registration information are provided at the same position on the paper form. This feature provides advantageous features such as the user can interact with registration information with the sensing device such that coincident coded data is sensed at the same location.

Claim 21 specifies that the computer system receives movement data from the sensing device. The movement data is generated by the sensing device using at least some of the sensed coded data. None of the cited documents show receiving movement data from the sensing device. Furthermore, none of the cited documents show the sensing device generating coded data using at least some of the sensed coded data. This feature is advantageous as the sensing device does not require accelerometers or gyroscopes to determine the movement of the sensing device.

Consideration of the newly added claims is also respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under *35 USC § 103*. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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